

**REMARKS**

The Final Office Action mailed on May 5, 2006 has been noted, and its contents carefully studied. The undersigned representative respectfully requests reconsideration of the rejections under 35 U.S.C. §§ 102 and 103 in light of the above amendments and these remarks.

Claims 14-18 and 21-28 are pending in the present application. Claim 14 has been amended as set forth above. Claims 19, 20 and 29 have been cancelled. The pending claims stand rejected as indicated below. Claims 14-17 and 28 have are rejected under 35 U.S.C. § 102(b) as being unpatentable over the teachings of McDonald. Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of McDonald. Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of McDonald in view of the teachings of Bussells. Claims 22-27 are allowed.

**Rejection of claims 14-17 and 28 under 35 U.S.C. § 102(b)**

In the present Office Action, claims 14-17 and 28 are rejected as being anticipated by the teachings of McDonald. Briefly, the Office Action asserts that McDonald discloses a screw compressor comprising a screw with an outer threading, the outer threading having a plurality of pitches that decreases in the longitudinal direction of the screw, an outer casing having an inner side that faces the thread of the screw, appliances that prevent matter passing through the screw from rotating along with the screw, a conduit for liquid supply arranged inside the screw and having a mouth on the outside of the screw (thus rotating with the screw), and that the screw compressor is arranged to press the liquid that is supplied to the matter via the mouth of the conduit axially backward in the longitudinal direction of the screw and towards the inlet end of

the screw compressor. The undersigned representative respectfully disagrees with this finding of anticipation for the reasons presented below.

In response thereto, the undersigned representative has amended claim 14 to recite “a water-tight casing, which is impervious to liquid in an entire area between the inlet end and the outlet end” and that “the screw compressor is arranged so that the liquid is supplied to the matter only when the matter has reached a dry content of at least 35%” (which limitations were previously recited in now-cancelled claims 19, 20 and 29).

As noted above, the Office rejected (now-cancelled) claim 29, as being anticipated by McDonald, asserting that “McDonald discloses the screw compressor in an arrangement as claimed, therefore, the arrangement of the compressor allowing the liquid to supply to the matter when the matter has reached a dry content of at least 35 percent.” However, the Office has also indicated that claims 22-27 are allowed, as none of the cited references teach “supplying a washing agent to the wet matter with a dry content of at least 35%, whereby the washing agent is supplied to the wet matter with a dry content of at least 35% via the rotating screw so that the washing agent is uniformly supplied to the wet matter with a dry content of at least 35%; and additional compressing of the wet matter with a dry content of at least 35%, after the supplying of the washing agent, wherein the washing agent that is supplied to the wet matter with a dry content of at least 35% is pressed axially backwards through the screw compressor towards the inlet end of the screw compressor.” It therefore appears that the Office has refused to give patentable weight to the limitation previously recited in claim 29 (and now recited in claim 14), presumably because the limitation previously recited in claim 29 is not explicitly recited in terms of structural limitations. The undersigned representative respectfully disagrees with this assertion. The MPEP in section 2173.05(g) states:

“A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” (emphasis added)

The undersigned representative respectfully submits that in the former claim 29, the limitation that the screw compressor “is arranged so that the liquid is supplied to the matter when the matter has reached a dry content of at least 35%” is a patentably distinct limitation to a person of ordinary skill in the art, as it describes a distinct and necessary feature of the invention, and that this limitation patentably distinguishes the pending claims from the teachings of McDonald.

Although the Final Office Action asserts that McDonald “discloses the screw compressor in an arrangement as claimed, therefore, the arrangement of the compressor allowing the liquid to supply to the matter when the matter has reached a dry content of at least 35%,” the undersigned representative notes that the Final Office Action does not point to any teaching in McDonald that the liquid is supplied to the matter only when the matter has reached a dry content of at least 35%. Since this is a functional limitation of the pending claims, the undersigned representative respectfully submits that this feature distinguishes claim 14 from McDonald. Moreover, even assuming, *arguendo*, that McDonald’s device is theoretically capable of this feature, that, by itself, does not equate to McDonald actually teaching this feature. For at least the above reasons, the undersigned representative therefore respectfully requests that this rejection be withdrawn.

**Rejection of claim 18 under 35 U.S.C § 103(a) as being unpatentable over McDonald**

According to well-established precedent, the Patent Office bears the initial burden of factually supporting any prima facie conclusion of obviousness. Referring to MPEP § 2142, in order to establish a prima facie case of obviousness, three basic criteria must be met:

(1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) there must be a reasonable expectation of success; and

(3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present Final Office Action, claim 18 is rejected as being obvious over the teachings of McDonald. For the reasons presented above, the undersigned representative respectfully submits that claim 14 (as amended) is allowable over the cited prior art. Since claim 18 depends from claim 14, the undersigned representative respectfully submits that claim 18 is therefore now also allowable and respectfully requests that this rejection be withdrawn.

**Rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Bussells**

In the present Final Office Action, claim 21 is rejected as being obvious over the teachings of McDonald in view of the teachings of Bussells. In view of the above-presented amendments and arguments, the undersigned representative respectfully submits that claim 14 is

allowable over the prior art. Since claim 21 depends from claim 14, the undersigned representative respectfully submits that claim 21 is therefore now also allowable and respectfully requests that this rejection be withdrawn.

**Allowable subject matter of claims 22-27**

In the present Final Office Action, the Examiner has indicated that claims 22-27 are allowable. The undersigned representative thanks the Examiner for this indication of allowable material.


**CONCLUSION**

In view of the above amendments and comments, and the Examiner's indication of allowable material, it is respectfully submitted that the application is now in a condition for allowance. Accordingly, issuance of a Notice of Allowance is earnestly solicited.

The undersigned representatives reserve the right to file continuations to seek protection for other novel aspects of the present invention, including those included in any cancelled claims. Should the Examiner have any comments, questions or suggestions of a nature necessary to expedite prosecution of the application, he/she is courteously requested to contact the undersigned representative at the number listed below. Furthermore, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

Date: 8/1/06  
KILPATRICK STOCKTON LLP  
Suite 900  
607 14<sup>th</sup> Street, N.W.  
Washington, D.C. 20005  
(202) 508-5800 (phone)  
(202) 508-5858 (fax)

By:   
John W. Ball, Jr.  
Registration No. 44,433